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*AS*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/281,809	03/31/99	LIU	B 197/K38-1142

WENDEROTH LIND & PONACK  
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IM52/0905

 EXAMINER

GRENDZYNISKI, M

 ART UNIT PAPER NUMBER

1774

DATE MAILED: 09/05/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Ex Parte Reexamination Advisory Action</b>	Control Number 09/281,809	Patent Under Reexamination LIU ET AL.
	Examiner Michael E. Grendzynski	Art Unit 1774

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE PROPOSED RESPONSE FILED 20 August 2001 FAILS TO OVERCOME ALL OF THE REJECTIONS IN THE FINAL REJECTION MAILED 24 April 2001. Therefore, unless a timely appeal is filed, or other appropriate action by the patent owner is taken to overcome all of the outstanding rejection(s), this *ex parte* reexamination proceeding WILL BE TERMINATED and a Notice of Intent to Issue *Ex Parte* Reexamination Certificate will be mailed in due course. Any finally rejected claims, or claims objected to, will be CANCELLED.

THE PERIOD FOR RESPONSE IS EXTENDED TO RUN 3 MONTHS FROM THE MAILING DATE OF THE FINAL REJECTION.

(Extensions of time are governed by 37 CFR 1.550(c))

1.  Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within the extended period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).
2.  The proposed amendment(s) will not be entered because:
  - (a)  they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  they raise the issue of new matter (see NOTE below);
  - (c)  they are not deemed to place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3.  Patent owner's proposed response filed \_\_\_\_\_ has overcome the following rejection(s): \_\_\_\_\_
4.  The proposed new or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5.  The a) affidavit/declaration, b) exhibit, or c) request for reconsideration has been considered but does NOT overcome the rejection(s) because: see attached sheet. (Amendment will be entered)
6.  The affidavit/declaration or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) patentable and/or confirmed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-5, 7-18, and 23-26

Claim(s) not subject to reexamination: \_\_\_\_\_

8.  The proposed drawing correction filed on \_\_\_\_\_ a) has b) has not been approved by the Examiner.
9.  Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_.
10.  Other: \_\_\_\_\_



BRUCE H. HESS  
PRIMARY EXAMINER

cc: Requester (if third party requester)

***Response to Arguments***

1. Applicants' arguments filed 8/20/01 have been fully considered but they are not persuasive. Applicants argue that since the Examples 5 and 7-12 use Vitasil® 1500 (a non-colloidal white carbon), that Miyamoto does not teach the use of colloidal silica with the specified particle sizes. Miyamoto, however, discloses the use of colloidal particles within applicants' claimed range. Applicants, on p 13 of the specification, disclose the manner by which the claimed pore volume ratio is obtained is through the addition of particles having diameters of from 10 to 300 nm. Miyamoto, on col. 4, ll 36-37, discloses that the colloidal particles used in its receptive layer have a size of 0.10  $\mu\text{m}$  or below. This value falls within applicants' claimed ranges. Miyamoto further discloses the use of Snowtex®, a known colloidal silica in the art. See, e.g., Example 1. As such, the rejection is maintained for the reasons of record.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Grendzynski whose telephone number is 703-305-0553. The examiner can normally be reached on Maxi-Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703-308-2376. The fax phone numbers for the organization where this application or proceeding is

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assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3599.



Michael E. Grendzynski  
Assistant Examiner  
September 2, 2001

BRUCE H. HESS  
PRIMARY EXAMINER